

REMARKS

Claims 1 and 25 have been amended. Claims 1-32 and 53-55 are presently pending in the application. No new matter has been added.

I. INDEFINITENESS REJECTION

The Office Action rejected claims 1-32 and 53-55 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Regarding this rejection, Applicants direct the Examiner's attention to the paragraph bridging pages 13 and 14 of the current application which states that the membranes of the present invention have a function of "inhibiting the unwanted adhesions and scarring." This language has been amended herewith to state that the membranes "provid[e] adhesion-inhibition by inhibiting the unwanted adhesions and scarring." Also, each of claims 1 and 25 has been amended to recite an adhesion-inhibition membrane "for inhibiting adhesions and scarring." No new matter has been added. Accordingly, the adhesion-inhibition term in the claim language is adequately defined and definite, and furthermore is particularly pointed out and distinctly claimed in the invention. Applicants request that this rejection be reconsidered and withdrawn.

II. DOUBLE-PATENTING (OBVIOUSNESS-TYPE) REJECTION

The Office Action rejected claims 1-32 and 53-55 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of U.S. Patent No. 6,673,362. Applicants respectfully disagree with this rejection and do not believe the current rejection has sufficient merit. For one, the same rejection was overcome, already, with regard to claims 1-32 in the Terminal Disclaimer submitted by Applicants on April 16, 2007. The overcoming of this rejection is evidenced and confirmed on page 2 of the Office Action

dated August 3, 2007. However, in an effort to expedite the prosecution of the present application, Applicants submit herewith a Terminal Disclaimer. Accordingly, Applicants request that this rejection be reconsidered and withdrawn.

III. PRIOR-ART REJECTIONS

Regarding the prior-art rejections, the Office Action rejected claims 1-32 and 53-55 as being unpatentable under 35 U.S.C. § 103(a) over Totakura et al. (U.S. Patent No. 5,795,584), Vyarkaram et al. (U.S. Patent No. 6,333,029) and Tang et al. (U.S. Patent No. 5,412,068), and rejected claims 6-10, 13 and 14 as being unpatentable under 35 U.S.C. § 103(a) over Totakura et al., Vyarkarnam et al. and Tang et al. as applied to claims 1-5, 15-17, and 19-32, and further in view of Lemperle et al. (U.S. Patent No. 6,391,059), Lemperle et al. (U.S. Patent No. 6,280,473), and Mansmann, K. (U.S. Patent No. 6,530,956). Applicants respectively disagree with these rejections.

The Applicants would like to respond initially to certain allegations set forth in the outstanding Office Action, by referencing and incorporating herein the entire content of the remarks from Applicants' prior Response.

It would appear, now, that a cornerstone of the outstanding Office Action's prior-art rejections is founded upon an issue that has developed with regard to the "adhesion-inhibition" term in the independent claims. (See, for example, page 6, lines 1-4 and page 19, line 13-18 of the latest Office Action.) More particularly, the Office Action appears to contend that claims 1 and 25 suffer from a lack of support in the specification for the "adhesion-inhibition" limitation.

Regarding this contention, it is without merit, as evidenced by the current amendments to the Detailed Description and claims, and by the above comments made in connection with the indefiniteness rejection.

Furthermore, the claimed invention would not have been obvious for reasons including the following. Features of the present invention are synergistic, and were not by any means merely thrown together from a laundry list of attributes. The unique combinations include the

provision of a simple-to-make (e.g., from simple compositions/reactions; cf. Pub. US07/0116739, par. 0007 and 0008) anti-adhesive membrane that offers reduction in both chemical tissue inflammation (e.g., the membrane is ultra-thin, for less inflammation during resorption; cf. Pub. US07/0116739, par. 0051) and mechanical tissue inflammation (e.g., non-leaking barrier, smooth, non-porous, cf. Pub. US07/0116739, par. 0047 and 0050; yet strong enough to have value and versatility; cf. par. 0031 and 0032, 0043). Relatively high inherent viscosities facilitate manufacture/handling of the fragile, ultra-thin membranes (cf. par. 0010, 0031, 0032). Multiple points of novelty are present, corresponding to multiple ranges of values. For example, a claimed range of thicknesses of about 0.001 mm to about 0.300 mm does not mean that all values in the range are admitted interchangeable equivalents. Rather, it means that Applicants' attorney had advised that very broad ranges be provided in certain places of the application to prevent easy design-around activities by competitors seeking to copy, in this example, other aspects of the invention such as the inherent viscosity range or the biasing aspect. For instance, a claim directed to multiple, independently-novel features should be drafted with the broadest ranges (not the narrowest) for each of those features. Regarding thicknesses, continuing with the instant example, the broad range is provided in the independent claim but then more preferred ranges are recited in the dependent claims. It is described in Applicants' specification that preferred thicknesses are 0.015 mm to about 0.025 mm (c.f. Pub. US07/0116739, par. 0038). Indeed, an actual product corresponding to this invention is sold under the name of SurgiWrap, indicating its extremely thin construction. Due to its thin architecture, other aspects were developed to enhance its strength. One such feature is formation of the membrane from a polymer having a pre-formation inherent viscosity that is relatively high. Again, while the independent claims contain relatively broad characterizations of the inherent viscosity, these characterizations were broadly recited upon the advice of counsel to facilitate the blockage of competitors' activities seeking to easily design-around the claimed invention; more preferred ranges are recited in dependent claims and are described in Applicants' specification (c.f. Pub. US07/0116739, par. 0031 and 0032).

The preceding information and incorporated content address concerns of the Examiner such as those set forth in the last paragraph on page 5 of the Office Action. As for the Office Action's statements on, for example, page 4, lines 4-6, and page 7, lines 3-8, they are clearly based upon hindsight as evidenced by the fact that the only claim elements (e.g., adhesion-inhibition), and/or teachings and/or motivations to combine, are provided by the Examiner's reference to nothing other than Applicants' very own pending specification.

Applicants maintain that the claimed invention is neither anticipated nor obvious in view of any of the prior-art references of record, taken separately or together, in any combination, either in structure or in process. Applicants submit the following outline, taken from the Response filed March 20, 2008, for emphasis:

- (1) Totakura et al. fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and 25), smooth surfaces (claims 1 and 25), non-porosity (claim 1), and a thickness of about .001 mm to 0.300 mm (claims 1 and 25);
- (2) Vyarkaram et al. fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and 25), smooth surfaces (claims 1 and 25), and non-porosity (claim 1);
- (3) Tang et al. fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and 25), smooth surfaces (claims 1 and 25), and non-porosity (claim 1);
- (4) Lemperle et al. (059) fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and

25), smooth surfaces (claims 1 and 25), non-porosity (claim 1), and a thickness of about .001 mm to 0.300 mm (claims 1 and 25);

(5) Lemperle et al. (473) fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and 25), smooth surfaces (claims 1 and 25), and non-porosity (claim 1); and

(6) Mansmann. fails to disclose or teach: adhesion-inhibition (claims 1 and 25), biased molecular orientation (claim 1), an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL (claims 1 and 25), smooth surfaces (claims 1 and 25), non-porosity (claim 1); and a thickness of about .001 mm to 0.300 mm (claims 1 and 25).

It is well established that a claim can be rejected on obviousness grounds only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior-art reference or combination of prior-art references. For a rejection under 35 U.S.C. § 103(a) to be proper, every limitation recited in the claim being rejected must be disclosed/evident in/from the collection of prior-art references. In the instant case, Applicants respectfully submit that the cited references neither disclose nor suggest each and every element that is recited in the rejected claims.

For instance, the **recitation** of an “adhesion-inhibition membrane...exhibiting an anti-inflammatory characteristic with a viscosity property greater than about 1 g/dL” (emphasis added) is not disclosed in not a single one of any of the references, taken separately/individually or even when taken together.

Since the **recitation** is in none of the “parts,” it certainly cannot be in the resulting “whole.” No Official Notice is taken by the Office Action, either. (By analogy, if a collection of documents nowhere mentions a briefcase, and no Official Notice is taken, clearly that collection does not disclose or obviate the formation of a briefcase, and certainly does not disclose or

obviate formation of a briefcase with a roller assembly, strap-on handle and stain-resistant material.)

With respect to the claims not specifically mentioned above, it is submitted that each of these claims is free and clear of the cited references, not only by virtue of its dependency upon the respective base claim but also for the totality of features recited therein.

Accordingly, the outstanding rejections under 35 U.S.C. § 103(a) are improper and should be withdrawn with expediency.

It is respectfully submitted that all of the current claims in the subject application distinguish over, and are allowable over, the prior art of record. Reconsideration and withdrawal of all rejections of record are respectfully requested.

In view of the above, Applicants believe that the application is now in condition for allowance, and an early indication of same is requested. The Examiner is invited to contact the undersigned with any questions.

The Commissioner is hereby authorized to charge any needed fees to Deposit Account 50-1600.

Respectfully submitted,



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